



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,075	06/06/2001	Hiroshi Endo	9976-9US (OB0025US)	6219

570 7590 01/13/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

ZHONG, CHAD

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,075

Applicant(s)

ENDO, HIROSHI

Examiner

Chad Zhong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

OFFICE ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2005 has been entered.

Applicant's arguments with respect to claims 1-2, 4-14, and 16-28 have been considered but are moot in view of the new ground(s) of rejection. Claims 1-2, 4-14, 16-28 are presented for examination. In amendment, filed on 11/17/2005, claims 1, 4-11, 13, and 19-24 are currently amended, claims 3, 15 have been cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-14, and 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keung et al. (hereinafter Keung), US 6,956,848, in view of Maeda, US 6,690,480.

4. As per claim 1, Maeda teaches a communication apparatus for use in a communication network system including a computer network being able to transmit and receive an file (Keung, Col. 9, lines 5-15, voice data, numeric data, ASCII data, and the like), based on a network address (Keung, Col. 8, lines 63 – Col. 9, line 5), a first telephone network being able to transmit and receive said file based on selected one of a plurality of first telephone numbers (Keung, Col. 8, lines 45-53, speed dial means the user is selecting a particular phone number based on a sequence

Art Unit: 2152

of DTMF keys; the first telephone network is Fig 1, item 8 on the left side of the figure; Fig 2, item 130 and 140), a second telephone network being able to transmit and receive said file based on a selected one of a plurality of second telephone numbers (Keung, Col. 8, lines 45-53, speed dial means the user is selecting a particular phone number based on a sequence of DTMF keys; the second telephone network is Fig 1, item 8 on the right side of the figure; Fig 2, item 130 and 140), a first address supplying device connected to said computer network being able to store the plurality of first telephone numbers and a first network address corresponding to each one of the first telephone numbers (Keung, Col. 8, line 60 – Col. 9, line 5, network address associated with the phone numbers are determined), and a second address supplying device connected to said computer network being able to store the plurality of second telephone numbers and a second network address corresponding to each one of the second telephone numbers (Keung, Col. 8, line 60 – Col. 9, line 5, network address associated with the phone numbers are determined, where this determination occurs at every telephone network), comprising:

an input section to input either of said selected first telephone number or said selected second telephone number to be provided to another communication apparatus to which said file is to be transmitted (Keung, Col. 8, lines 45-53), the selected first telephone number corresponding to said first telephone network and the selected second telephone number corresponding to said second telephone network (Keung, Col. 2, lines 30-45, where there is internal and external numbers corresponding to internal and external networks);

a judging section to judge whether said telephone number input through said input section corresponds to said first telephone network or said second telephone network (Keung, Col. 3, lines 23-30);

a number transmitting section to transmit said input telephone number, based on a judgment result by said judging section, to either of said first address supplying device if the input telephone number corresponds to said first telephone network, or to said second address

Art Unit: 2152

supplying device if the input telephone corresponds to said second telephone network (Keung, Col. 3, lines 25-45; Col. 5, lines 17-41; Col. 9, lines 25-30, calls get routed to internal or external numbers according to their phone numbers);

an address receiving section to receive, in response to said input telephone number transmitted from said telephone number transmitting section, said network address transmitted from said first address supplying device or said second address supplying device corresponding to said telephone number (Keung, Col. 8, lines 60 – Col. 9, line 5; Col. 9, lines 25-30, where the packets with the IP address headers are sent to the receiver side); and

a first transmitting section to transmit, based on said network address received by said address receiving section, said file to said another file communication apparatus through said computer network (Keung, Col. 8, lines 60 – Col. 9, line 5; Col. 9, lines 25-30; Col. 4, line 65 – Col. 5, line 7, where the message files are sent to the recipient side).

Keung does not explicitly teach image communication apparatus communicating image files.

Maeda teaches image communication apparatus communicating image files (Col. 4, lines 42-51, where an Internet fax system is taught).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate teachings of Keung with Maeda because the combination would improve the capabilities of Keung by allowing for transmission of images files along with voice message files over the network (Maeda, Col. 1, lines 35-45).

5. As per claim 2, Keung – Maeda disclose the invention substantially as rejected in claim 1 above, including said judging section judges whether said input telephone number has been registered (Keung, Col. 3, lines 25-30; Col. 8, lines 48-50, judgment section check to see if the phone number is already stored within the system).

6. As per claim 4, Keung – Maeda disclose the invention substantially as rejected in claim 1 above, including said image communication apparatus is provided with the correspondence functions of said first address supplying device and said second address supplying device as sections of said image communication apparatus (Maeda, Fig 3, it should be noted that Fig 3's fields are populated as per query to remote receivers. In one embodiment the receivers are remote fax machines, the local fax machine can fill table in Fig 3 in accordance with remote device capabilities. This is taught for example, in Col. 18, lines 15-35).

9. As per claim 5, Keung – Maeda disclose the invention substantially as rejected in claim 1 above, including a second image transmitting section to transmit the image to said another image communication apparatus through either of said first telephone network based on said selected first telephone number or said second telephone network based on said second telephone number (Maeda, Col. 18, lines 35-40; Keung, Col. 5, lines 15-40).

10. As per claim 6, Keung – Maeda disclose the invention substantially as rejected in claim 5 above, including a signal receiving section to receive, when said second image transmitting section transmits the image, using either of said selected first telephone number or said selected second telephone number, to said another image communication apparatus through either of said first telephone network based on said selected first telephone number or said second telephone network based on said selected second telephone number, a signal containing (Maeda, the signals are signals returned from the receiver side) a network address of said another communication apparatus (Maeda, Col. 18, lines 22-30, the internet address is transmitted by the remote computer and stored locally at the local computer if the remote device can support internet fax; Keung, Col. 9, lines 1-10) provided to said image communication apparatus on a receiver side which is returned, in response to said transmitting of said image, from said another image communication apparatus and wherein said first image transmitting section is adapted to transmit a second image

Art Unit: 2152

contained in said signal received by said signal receiving section, based on said network address of said another image communication apparatus, to said another image communication apparatus through said computer network (Maeda, Col. 18, lines 15-40).

11. As per claim 7, Keung – Maeda disclose the invention substantially as rejected in claim 6 above, including a storage section to store correspondence between said input telephone number (Keung, Col. 8, lines 47-51), used by said second image transmitting section when said first image is transmitted and received through either of said first telephone network based on said selected first telephone number or said second telephone network based on said selected second telephone number (Maeda, Col. 1, lines 35-50; Keung, Col. 5, lines 23-40), and said network address of said another image communication apparatus received by said signal receiving section when said signal is received (Maeda, Fig 3; Col. 6, lines 20-30; Keung, Col. 9, lines 1-15).

12. As per claim 8, Keung – Maeda disclose the invention substantially as rejected in claim 5 above, including said second image transmitting section, transmits said image using either of said selected first telephone number or said selected second telephone number through one of said first and second telephone networks when said first transmitting section fails to transmit said image based on said network address through said computer network (Maeda, Fig 4; Col. 12, lines 30-40, lines 50-63, wherein the user designate an internet fax mode, however the receiver does not support Internet fax mode, hence the fax will be sent via regular telephone number; Keung, Col. 3, lines 25-45).

13. As per claim 9, Keung – Maeda disclose the invention substantially as rejected in claim 5 above, including an operation section to designate, priority of transmission by said first image transmitting section through said computer network or transmission by said second image transmitting section through one of said first and second telephone networks (Maeda, Col. 12, lines 30-40, lines 50-60; see also Fig 1, item 3 and 4, wherein the fax can be transmitted either via

the internet or regular telephone network; Keung, Col. 3, lines 25-45).

14. As per claim 10, Keung – Maeda disclose the invention substantially as rejected in claim 9 above, including said operation section, when said first image transmitting section fails to transmit said image through said computer network, designates whether said image is to be transmitted by said second image transmitting section through one of said first and second telephone networks (Col. 12, lines 50-62; wherein the user designate an internet fax mode, however the receiver does not support internet fax mode, hence the fax will be sent via regular telephone number; Keung, Col. 3, lines 25-45).

15. As per claim 11, Keung – Maeda disclose the invention substantially as rejected in claim 1 above, including said first telephone network is an inside telephone network that is able to transmit and receive said image based on said selected first telephone number being said inside telephone number and said second telephone network is an outside telephone network that is able to transmit and receive said image based on said selected second telephone number being said outside telephone number and wherein said computer network is either of an intranet or the Internet that is able to transmit and receive said image based on said network address being an IP (Internet Protocol) address (Maeda, Fig 2-4; Col. 1, lines 35-41, wherein the Maeda is able to transmit internet faxes on the external network after receiving the internet address; Keung, Col. 3, lines 25-45).

16. As per claim 12, Keung – Maeda disclose the invention substantially as rejected in claim 1 above, including said number transmitting section transmits said input number through said computer network and said address receiving section receives said network address through said computer network (Maeda, Fig. 3; Col. 1, lines 35-45; Keung, Col. 9, lines 1-10).

17. As per claim 13, the claim is rejected for the same reasons as rejection to claim 1 above.

Art Unit: 2152

18. As per claim 14, the claim is rejected for the same reasons as rejection to claim 2 above.

19. As per claim 16, Keung – Maeda disclose the invention substantially as rejected in claim 13 above, including said image communication system is provided with, as its function section, either of said first address supplying device or said second address supplying device (Maeda, Col. 6, lines 22-40).

20. As per claim 17, Keung – Maeda disclose the invention substantially as rejected in claim 16 above, including said image communication apparatus further includes an operation section to designate either of said image communication apparatus having either of said first address supplying device or said second address supplying device as a device from which said network address is acquired (Maeda, Col. 6, lines 22-40, it should be noted that address supplying devices are receiving units so there are plurality of receiving devices resulting in at least two address supplying devices; Keung, Col. 9, lines 1-10).

21. As per claim 18, the claim is rejected for the same reasons as rejection to claim 12 above.

22. As per claim 19, the claim is rejected for the same reasons as rejection to claim 1 above.

23. As per claim 20, Keung – Maeda disclose the invention substantially as rejected in claim 19 above, including:

second transmitting said image to said another image communication apparatus, based on said first telephone number, through a first telephone network and a second telephone network (Keung, Col. 5, lines 15-40; Col. 9, lines 1-15; Maeda, Col. 1, lines 35-50); and

selectively performing either of said first transmitting and said second transmitting (Maeda, Col. 2, lines 30-42; Keung, Col. 5, lines 15-40).

Art Unit: 2152

24. As per claim 21, the claim is rejected for the same reasons as rejection to claim 9 above.

25. As per claim 22, the claim is rejected for the same reasons as rejection to claim 10 above.

26. As per claim 23, Keung – Maeda disclose the invention substantially as rejected in claim 19 above, including

receiving a signal which is to be received from said another image communication apparatus through either of said first telephone network or said second telephone network and which contains a computer address of said another image communication apparatus (Maeda, Col. 1, lines 35-45; Keung, Col. 9, lines 1-27);

extracting a computer address of said another image communication apparatus from said received signal (Keung, Col. 8, line 63 – Col. 9, line 15); and

wherein said first transmitting is used to transmit said image, based on said extracted computer address, through said computer network to said another image communication apparatus (Maeda, Col. 18, lines 15-40; Keung, Col. 9, lines 1-25).

27. As per claim 24, the claims is rejected for the same reasons as rejection to claim 1 above, additionally, Keung teaches first address supplying device having a plurality of telephone numbers associated only with outside communications, and a second supplying device used in inside communication having a plurality of telephone numbers associated with only said inside communications (Keung, Col. 3, lines 25-45; Col. 9, lines 1-15).

28. As per claim 25, Keung – Maeda disclose the invention substantially as rejected in claim 24 above, including the first image communication apparatus and the second image communication apparatus each respond to an outside telephone number used for outside communication, an inside telephone number used for inside communication, and a network address (Maeda, see for example, table 3, where the outside phone numbers correspond to a

Art Unit: 2152

network address; Keung, Col. 3, lines 25-45).

29. As per claims 26-27, the claims are rejected for the same reasons as rejection to claim 1 above.

30. As per claims 28, the claim is rejected for the same reasons as rejection to claims 1 and 6 above.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "IMAGE COMMUNICATION APPARATUS IMAGE COMMUNICATION SYSTEM AND IMAGE COMMUNICATION METHOD".

- | | | |
|------|-----------------|-------------|
| i. | US 2003/0039237 | Forsolw |
| ii. | US 6584098 | Dutnall |
| iii. | US 6215790 | Voit et al. |
| iv. | US 6587684 | Hsu et al. |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAROENCHONWANIT, BUNJOB can be reached on (571)272-3913. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CZ

January 9, 2006

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a large, stylized flourish at the end.

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER